

## **REMARKS/ARGUMENTS**

The claims are 52-114. Claims 52-59, 61-62, 64-65, 69-73, 75-78, 80-93, 98-99, 102-112 and 114 have been amended to better define the invention or to provide antecedent basis for certain terms reflected therein. A Substitute Specification including a replacement Abstract of the Disclosure has also been submitted, along with a marked-up copy showing the changes over the previous version. Reconsideration is expressly requested.

Applicants would like to thank the Examiner for the courtesy of a telephone interview on April 15, 2008, the substance of which is set forth herein. During the interview, Applicants' attorney pointed out that the embodiment shown in FIG. 4 is not really different from the embodiments shown in FIGS. 1-3, as FIG. 4 simply shows a representation of the second functional status of the shut-off instrument shown in FIGS. 1-3. FIG. 4 shows shut-off instrument 1 having shut-off element 23 with an open flow channel 6 with shut-off element 23 positioned completely inside slide valve chamber 11. FIG. 4 also shows a variant of the housing in dashed lines along the plane 90 to show that the housing lid 10 can be removable from the rest of the housing body. The Examiner indicated that he had made the election of species based on the statement in the application that FIG. 4 shows a "different

embodiment" of the shut-off instrument in cross-section and suggested that Applicants amend the specification to clarify that FIG. 4 shows the embodiment of the shut-off instrument of FIG. 1 in cross-section with the shut-off element positioned completely inside the slide valve chamber and showing in dashed lines a variant of the instrument housing. Accordingly, Applicants have so amended the specification, which amendment is included in the Substitute Specification as indicated in the marked-up version of the Specification.

During the interview, Applicants' attorney also advised that there was an additional embodiment shown in FIG. 11, and Applicants respectfully request that this embodiment be examined as well in this application.

As stated above, Applicants elect Group I, claims 52-102 and Species I, FIGS. 1-3 (which it is respectfully submitted also encompasses FIG. 4) with claims 52-102 readable thereon, for further prosecution and respectfully traverse the requirement for restriction for the following reasons.

With respect to the species requirement, Applicants respectfully submit that as stated above, FIG. 4 relates to the same species as FIGS. 1-3 with the additional feature showing that

the housing lid can be removed from the rest of the housing body.

Moreover, it is believed that any search for the invention embodied in Group I and the species embodied in FIGS. 1-3 (and FIG. 4) would necessarily include a search for the invention embodied in Group II and the species embodied in FIG. 11. Thus, the simultaneous search for both groups and all species is believed not to constitute an unreasonable search for the Patent Examiner.

In addition, it is believed that the objectives of streamlined examination and compact prosecution would be promoted if a search were conducted simultaneously for all the groups and species. Also, the necessity of filing multiple patent applications in this case does not serve to promote the public interest because of the extra expense that is involved, in filing fees and examination costs, as well as the burden upon the public, due to the necessity of searching through a multiplicity of patent files in order to find the complete range of the subject matter claimed in several different patents that could otherwise be found in one issued patent only.

Applicants reserve the right to file a divisional application for the non-elected group and species.

For all these reasons, it is respectfully requested that the restriction requirement under 35 U.S.C. 121 be withdrawn and that an action on the merits of all the claims be rendered.

In the Office Action, the declaration was rejected as being defective because it refers to "material to the examination" and "\$1.56(a)" instead of referring to -- material to patentability -- and -- \$1.56 --. As discussed at the telephone interview on April 15, 2008, the January 22, 2008 Notice from John W. Dudas, Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office indicates that the Office has waived the express language requirements of 37 C.F.R. 1.63(b)(3), where the oath or declaration was filed prior to June 1, 2008, as was the case here. Accordingly, it is respectfully submitted that the objection to the declaration as being defective should be withdrawn. At the telephone interview on April 15, 2008, the Examiner indicated that in view of the January 22, 2008 Notice, Applicants' declaration was not defective and that he would withdraw the objection on that basis.

The Abstract of the Disclosure was objected to because of certain informalities and the specification was objected to as lacking headings and as referring to claims. In response, Applicants have submitted herewith a Substitute Specification

including a replacement Abstract of the Disclosure correcting these informalities, which it is respectfully submitted overcomes the Examiner's objection to the Specification and Abstract of the Disclosure on this basis.

The Office Action also appeared to indicate that Applicants should amend the specification to include material incorporated by reference. At the telephone interview, this statement in the Office Action was discussed, and the Examiner agreed that there was no need to amend the specification on this basis.

Claims 52-114 were objected to on the grounds of certain informalities set forth on pages 9-10 of the Office Action and claims 52-114 were rejected under 35 U.S.C. 112, second paragraph, for the reasons set forth in paragraph a) on pages 10-11 of the Office Action. In response, Applicants have amended claims 52-59, 61-62, 64-65, 69-73, 75-78, 80-93, 98-99, 102-112 and 114 to correct these informalities. It is respectfully submitted that all currently pending claims fully comply on formal grounds and with the requirements of 35 U.S.C. 112, second paragraph, and Applicants respectfully request that the objections and rejections on this basis be withdrawn.

Claims 52-114 were rejected under 35 U.S.C. 112, first

paragraph, as failing to comply with the written description requirement as set forth in paragraph 16 on page 10 of the Office Action. Specifically, the Examiner stated that claim 52 makes no sense as the external dimension 29 that is slightly smaller appears to be of the outer disc 40 and not the sealing elements 34 which changes the entire scope of the claims. The Examiner also stated that claims 52 and 103 have ribs 33 and also "a mutually designed structure" in which the specification and claims do not make sense as to how this works.

In response, Applicants have amended claim 52 to clarify that it is the main body 28 which has the external dimension that is slightly smaller than the normal width 9 of the flow channel 6 as can be seen in the drawings. In accordance with Applicants' invention as recited in claim 52, the inner parts of the shut-off element can be mounted through the two openings of the flow channel without the necessity to provide a multi-part housing. Regarding the expression "a mutually designed structure," Applicants have amended claim 52 to specify that the ribs projecting over its surfaces are arranged to form a matching structure for the engaged arrangement of the sealing elements and respectfully traverse the Examiner's rejection for the following reasons:

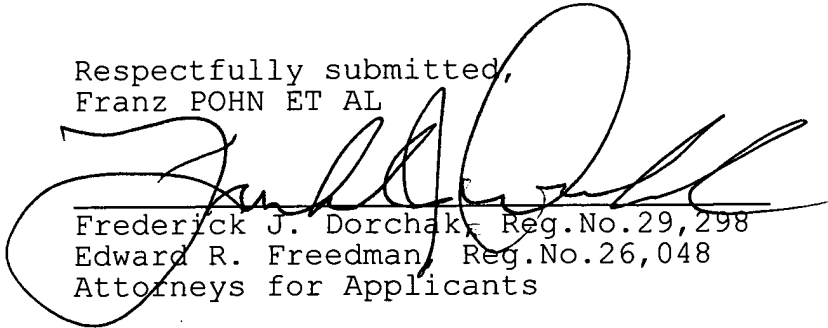
Under 35 U.S.C. 112, the detailed description of the invention need be only in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains or with which it is most nearly connected to make and use the same. It is respectfully submitted that one reading the specification would understand that by "a mutually designed structure" the surfaces of the main body and of the sealing elements should match with each other. For example, from FIG. 2, one can note that the cross section of the main body has a rather complicated design and the sealing elements 34 fit to the design of the surface of the main body. For clarification purposes, claim 52 has been amended to recite "matching" structure, and it is believed that the recitation in claim 103 regarding a "compatible" structure for the arrangements of the sealing elements is sufficiently clear that one skilled in the art would understand what was intended. Accordingly, it is respectfully submitted that the rejection of claims 52-114 on the basis of 35 U.S.C. 112, first paragraph, should be withdrawn.

In summary, 52-59, 61-62, 64-65, 69-73, 75-78, 80-93, 98-99, 102-112 and 114 have been amended, along with the specification and Abstract of the Disclosure as reflected in the enclosed Substitute Specification. Group I, claims 52-102 and Species I, FIG. 1-3, have also been elected, with traverse. For all these

reasons, it is respectfully requested that the Restriction Requirement under 35 U.S.C. 121 be withdrawn, that an action on the merits of all the claims be rendered, and that all claims should be considered in condition for allowance.

Respectfully submitted,  
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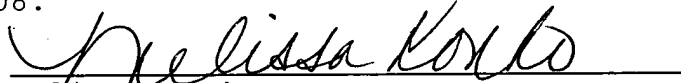
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Enclosures:

Appendix A - Clean copy of Specification  
Appendix B - Marked-up copy of Specification

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on May 19, 2008.



Melissa Konko



# APPENDIX A

CLEAN COPY  
OF SUBSTITUTE SPECIFICATION

U.S. PATENT APPLICATION SERIAL NO. 10/519,288